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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/473,662 | 12/29/1999 | WILLIAM M. RISEN JR. | RISEN-01 | 1274 |

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04/10/2002

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EXAMINER

ROSEN, NICHOLAS D

ART UNIT

PAPER NUMBER

2165

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Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|------------------------------|--|
| Office Action Summary | Application No. 09/473,662 | Applicant(s) RISEN ET AL. | |
| | Examiner Nicholas D. Rosen | Art Unit 2165 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11,13-15,17,19,21,22,25 and 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11,13-15,17,19,21,22,25 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

Claims 1-11, 13-15, 17, 19, 21-22, and 25-26 have been examined.

Drawings

The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81. No new matter may be introduced in the required drawing.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4, 9-11, 13-15, 17 and 19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 6, 8-11, 14, 16, and 17 of U.S. Patent No. 6,018,714. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the instant application recites, in essence, a method of doing what claim 6 of the '714 patent recites a data processing system for doing. Claim 2 of the instant application recites

essentially what is implicit in claim 1(b) of the '714 patent. Claims 3 and 4 of the instant application recite providing an evaluation, held to be essentially the same as determining a value, means for doing which are recited in claim 6 of the '714 patent. Claims 9, 10, and 11 of the instant application recite essentially the same limitations as claims 8, 9, and 10, respectively, of the '714 patent. Claims 13 and 14 of the instant application are largely similar to claim 16 of the '714 patent. Claims 15 and 17 of the instant application are largely similar to claim 11 of the '714 patent. Claim 19 is closely parallel to claim 14 of the '714 patent.

Claim 22 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,018,714. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 22 of the instant application recites, in essence, a method of doing a broadened version of what claim 1 of the '714 patent recites a data processing system for doing; claim 22 of the instant application does not significantly narrow the limitations.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 4, 7, and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 2 is unclear in that it fails to distinguish

explicitly whether the first fee is an insurance premium, obtained in exchange for entering into a contract to provide compensation, or a consulting fee, obtained in exchange for declaring one's willingness to enter into such a contract. Claims 4, 7, and 8 are unclear in that they depend on claim 2.

Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 22 is unclear because it recites assigning a value to a patent right owned by a first party, and agreeing to provide compensation for a reduction in the value of the patent right to a person with an interest in the first party, but also recites that the insurance premium is paid in connection with a transfer of ownership of the patent right. If the ownership of the patent right has been transferred to a second party by the time of the unexpected reduction in value, a person with an interest in the first party has apparently ceased, as such, to have an insurable interest in the value of the patent right. If the ownership of the patent right still belongs to the first party at the time of the reduction in value, as it did when a value was assigned to the patent right, it is unclear how the insurance premium can be paid in connection with a transfer of ownership of the patent right.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 25 and 26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims describe non-functional descriptive matter per se, which is not within the technological arts.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Encyclopaedia Britannica. The Encyclopaedia Britannica discloses that insurance is written against a wide variety of contingencies (Volume 6, page 336, column 1, lines 27-54). Hence, it would have been obvious to one of ordinary skill in the art of insurance at the time of applicant's invention to write insurance against an unexpected change in value of an intellectual property asset. The Encyclopaedia Britannica article does not disclose the detailed steps claimed, but official notice is taken that it is well known in the art of insurance for insurers to obtain a description of an asset to be insured; determine the value of an asset to be insured; determine the cost of providing compensation for the destruction of an asset to be insured, or for an unexpected change in the value of an asset to be insured; and offer to provide compensation for an unexpected change in value of an asset to be insured. Hence, it would have been obvious to one of ordinary

skill in the art of insurance at the time of applicant's invention to carry out these steps with regard to an intellectual property asset, in order to obtain the obvious advantage of profiting from writing insurance on intellectual property assets.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Encyclopaedia Britannica as applied to claim 1 above, if the first fee of claim 2 is to be understood as an insurance premium. The Encyclopaedia Britannica further discloses that it is well known to obtain fees (premiums) in exchange for offering to provide compensation under specified circumstances (Volume 6, page 336, column 1, lines 54-58). Hence, it would have been obvious to one of ordinary skill in the art of insurance at the time of applicant's invention that an insurer would normally require and obtain a fee in exchange for offering to provide compensation for at least a portion of any unexpected change in value of an intellectual property asset, in order to achieve the obvious advantage of making rather than losing money from the business of insuring intellectual property assets.

In the alternative, if claim 2 is to be taken as disclosing, not the payment of an insurance premium, but the payment of a fee for merely offering to enter into a contract which would oblige the offeror to provide compensation, claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Encyclopaedia Britannica as applied to claim 1 above, and further in view of Friedman. Friedman teaches that the information that someone possessed of skill in evaluating risks and/or expert knowledge of the risks in a particular case has offered to insure an asset at a stated premium can be valuable even if the offer is not accepted (page 23, lines 24-28), and official notice is taken that it

is well known to pay consulting fees in exchange for valuable information. Hence, it would have been obvious to one of ordinary skill in the art of insurance at the time of applicant's invention for a person with an interest in the owner of an intellectual property asset to pay a fee in exchange for an offer to provide compensation for an unexpected change in the value of the intellectual property asset, in order to achieve the obvious advantage of acquiring independent evidence of the low risk of such an unexpected change of value. For the perspective of the offeror, it would have been obvious to one of ordinary skill in the art of insurance at the time of applicant's invention to accept a fee in exchange for offering to provide compensation in order to achieve the obvious advantage of being made richer by the fee.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Encyclopaedia Britannica as applied to claim 1 above, and further in view of Harbert. The Encyclopaedia Britannica article does not disclose, but Harbert teaches, the step of providing an evaluation of intellectual property assets (page 1, lines 35-38). Hence, it would have been obvious to one of ordinary skill in the art of insurance at the time of applicant's invention for an insurer to provide an evaluation of an intellectual property asset in order to achieve the obvious advantage of having grounds to judge whether a proposed insurance policy is likely to be profitable or the reverse to an insurer.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Encyclopaedia Britannica as applied to claim 2 above, and further in view of Harbert. The Encyclopaedia Britannica article does not disclose, but Harbert teaches, the step of providing an evaluation of intellectual property assets (page 1, lines 35-38). Hence, it

would have been obvious to one of ordinary skill in the art of insurance at the time of applicant's invention for an insurer to provide an evaluation of an intellectual property asset in order to achieve the obvious advantage of having grounds to judge whether a proposed insurance policy is likely to be profitable or the reverse to an insurer.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Encyclopaedia Britannica as applied to claim 1 above. The Encyclopaedia Britannica article does not expressly disclose accepting the offer to provide compensation, but official notice is taken that it is well known in the art of insurance for persons who have applied for insurance to accept the insurer's offer to provide compensation should certain specified expenses or misfortunes occur. Hence, it would have been obvious to one of ordinary skill in the art of insurance at the time of applicant's invention for a person with an interest in the owner of an intellectual property asset to accept an insurer's offer to provide compensation for an unexpected change in the value of that intellectual property asset, in order to achieve the obvious advantage of being compensated should an unexpected fall in the value of that intellectual property asset occur.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Encyclopaedia Britannica as applied to claim 5 above. The Encyclopaedia Britannica discloses that it is well known to pay fees (premiums) in exchange for insurance coverage (Volume 6, page 335, column 3, first paragraph of article on "insurance"). Hence, it would have been obvious to one of ordinary skill in the art of insurance at the

time of applicant's invention to pay a fee to an offeror for the stated advantage of receiving insurance coverage against major losses.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Encyclopaedia Britannica as applied to claim 2 above. The Encyclopaedia Britannica article does not expressly disclose accepting the offer to provide compensation, but official notice is taken that it is well known in the art of insurance for persons who have applied for insurance to accept the insurer's offer to provide compensation should certain specified expenses or misfortunes occur. Hence, it would have been obvious to one of ordinary skill in the art of insurance at the time of applicant's invention for a person with an interest in the owner of an intellectual property asset to accept an insurer's offer to provide compensation for an unexpected change in the value of that intellectual property asset, in order to achieve the obvious advantage of being compensated should an unexpected fall in the value of that intellectual property asset occur.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Encyclopaedia Britannica as applied to claim 7 above. The Encyclopaedia Britannica discloses that it is well known to pay fees (premiums) in exchange for insurance coverage (Volume 6, page 335, column 3, first paragraph of article on "insurance"). Hence, it would have been obvious to one of ordinary skill in the art of insurance at the time of applicant's invention to pay a fee to an offeror for the stated advantage of receiving insurance coverage against major losses.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Encyclopaedia Britannica as applied to claim 1 above. The Encyclopaedia Britannica article does not disclose that value includes at least one future value, but official notice is taken that it is well known that the value of an asset depends on its expected future value. Hence, it would have been obvious to one of ordinary skill in the art of insurance at the time of applicant's invention to insure an intellectual property asset, in order to achieve the obvious advantage of insuring the insured party against a fall in the future value of the intellectual property asset.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Encyclopaedia Britannica as applied to claim 9 above. The Encyclopaedia Britannica article does not disclose that the value of an asset includes its current value, but official notice is taken that it is well known that the value of an asset includes its current value. Hence, it would have been obvious to one of ordinary skill in the art of insurance at the time of applicant's invention to insure an intellectual property asset based on its current value, in order to achieve the obvious advantage of insuring the insured party against a fall in the current value of the intellectual property asset.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Encyclopaedia Britannica as applied to claim 1 above, and further in view of Harbert and of Mulcahy. The Encyclopaedia Britannica article does not disclose that intellectual property rights comprise patent rights, patent application rights, trademark rights, service mark rights, copyright rights, trade secret rights, and trade dress rights, but official notice is taken that intellectual property rights comprise patent rights, patent

application rights, trademark rights, service mark rights, copyright rights, trade secret rights, and trade dress rights. The Encyclopaedia Britannica teaches that it is well known to obtain insurance for a great variety of assets against a variety of contingencies (Volume 6, page 336, column 1, lines 27-54). In particular, it is well known to insure patent rights, as taught by Harbert (page 1, column 25-29). In addition, Mulcahy teaches that insurance may be written for patents, copyrights, and other forms of intellectual property (entire article, especially ninth text paragraph *et subseq.*). Hence, it would have been obvious to one of ordinary skill in the art of insurance at the time of applicant's invention to obtain insurance for any of the listed forms of intellectual property asset, for the obvious advantage of obtaining compensation should that intellectual property asset unexpectedly fall in value. Alternatively, from the perspective of the insurer, it would have been obvious to write insurance for any of the listed forms of intellectual property asset, for the obvious advantage of profiting from the premiums paid for such insurance.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Encyclopaedia Britannica as applied to claim 1 above, and further in view of Cripe. The Encyclopaedia Britannica article does not expressly disclose that a person with an interest in the first party includes at least one member selected from the group consisting of an officer of the first party, a director of the first party, a prospective purchaser of said at least one intellectual property asset, an officer of the prospective purchaser, and a director of the prospective purchaser. However, Cripe teaches that it is common procedure to obtain insurance coverage protecting a company, and its

individual directors and officers, from losses due to mismanagement (page 3, lines 1-4 of enclosed copy). Moreover, official notice is taken that it is well known for a purchaser or prospective purchaser to obtain insurance/guarantees on a purchase (note Friedman, page 23, lines 24-28). Hence, it would have been obvious to one of ordinary skill in the art of insurance at the time of applicant's invention for an officer of the first party, a director of the first party, a prospective purchaser of said at least one intellectual property asset, an officer of the prospective purchaser, or a director of the prospective purchaser, to obtain insurance against an unexpected change in the value of an intellectual property asset, for the obvious advantages of being protected from direct financial losses, and from liability for what might be construed as management.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Encyclopaedia Britannica as applied to claim 1 above, and further in view of Cripe. The Encyclopaedia Britannica article does not expressly disclose that a person with an interest in the first party includes at least one member selected from the group consisting of a prospective purchaser of said at least one intellectual property asset, an officer of the prospective purchaser, and a director of the prospective purchaser. However, Cripe teaches that it is common procedure to obtain insurance coverage protecting a company, and its individual directors and officers, from losses due to mismanagement (page 3, lines 1-4 of enclosed copy). Moreover, official notice is taken that it is well known for a purchaser or prospective purchaser to obtain insurance/guarantees on a purchase (note Friedman, page 23, lines 24-28). Hence, it would have been obvious to one of ordinary skill in the art of insurance at the time of

applicant's invention for a prospective purchaser of said at least one intellectual property asset, an officer of the prospective purchaser, or a director of the prospective purchaser, to obtain insurance against an unexpected change in the value of an intellectual property asset, for the obvious advantages of being protected from direct financial losses, and from liability for what might be construed as management.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Encyclopaedia Britannica as applied to claim 1 above. The Encyclopaedia Britannica article does not disclose that an unexpected change in value is based upon a legal determination of at least one of invalidity and unenforceability of an intellectual property asset. However, official notice is taken that it is well known that the value of an intellectual property asset is likely to change unexpectedly should a legal determination be made that the intellectual property asset is invalid and/or unenforceable. Hence, it would have been obvious to one of ordinary skill in the art of insurance at the time of applicant's invention to insure an intellectual property asset against a legal determination of its invalidity or unenforceability, in order to achieve the obvious advantage of being compensated for some or all of the losses incurred in the event of such a determination. Alternatively, from the perspective of the insurer, it would have been obvious to write insurance for an intellectual property asset against a legal determination of its invalidity or unenforceability, in order to make an insurance policy more comprehensive and desirable, and thus achieve the obvious advantage of being able to collect a higher premium on such an insurance policy.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Encyclopaedia Britannica as applied to claim 1 above, and further in view of Harbert. The Encyclopaedia Britannica article does not disclose analyzing the validity of intellectual property assets. However, Harbert teaches that an insurer of patents conducts an analysis based on a review of the patent, the business, and associated issues, including any history of litigation (page 1, lines 35-38). This is held to comprise analyzing the validity of the patent. Hence, it would have been obvious to one of ordinary skill in the art of insurance at the time of applicant's invention that determining the value of an intellectual property asset would include analyzing its validity, in order to achieve the obvious advantage of making an accurate assessment of the intellectual property asset's value.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Encyclopaedia Britannica as applied to claim 1 above. The Encyclopaedia Britannica article does not disclose that intellectual property assets commonly include patent rights, but official notice is taken that it is well known that intellectual property assets commonly include patent rights. Hence, it would have been obvious to one of ordinary skill in the art of insurance at the time of applicant's invention to have insurance of intellectual property assets include insurance of patent rights, in order to achieve the obvious advantage of profiting from the issuance of such insurance on a major section of the potential marketplace for intellectual property insurance.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Encyclopaedia Britannica as applied to claim 1 above. The Encyclopaedia Britannica

article does not disclose that an offer to provide compensation is made to a party with an interest in the first party in connection with transfer of ownership of an intellectual property asset to a second party. However, official notice is taken that it is well known for the seller or sellers of an asset to obtain an independent assessment of the asset's value, or to insure themselves against possible liability should the value of the asset unexpectedly change. Hence, it would have been obvious to one of ordinary skill in the art of insurance at the time of applicant's invention for persons with an interest in the owner of at least one intellectual property asset to insure themselves against an unexpected change in the value of said intellectual property asset in connection with the transfer of said at least one intellectual property asset to another owner, for the obvious advantage of obtaining protection against liability. Alternatively, from the insurer's perspective, it would have been obvious to offer insurance to a party with an interest in the owner of at least one intellectual property asset in connection with the transfer of said at least one intellectual property asset to another owner, for the obvious advantage of profiting from the receipt of premiums for such insurance, and/or from the receipt of consulting fees for declaring the willingness to offer such insurance.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Encyclopaedia Britannica and Friedman. The Encyclopaedia Britannica discloses that insurance is written against a wide variety of contingencies (Volume 6, page 336, column 1, lines 27-54). Hence, it would have been obvious to one of ordinary skill in the art of insurance at the time of applicant's invention to write insurance against an

unexpected change in value of a patent right. The Encyclopaedia Britannica article does not disclose the detailed steps claimed, but official notice is taken that it is well known in the art of insurance for insurers to assign a value to an asset to be insured; estimate the likelihood of an unexpected reduction in the value of that asset (e.g., of a ship sinking, a house burning down, etc.); and agree to provide compensation for an unexpected change in value of an asset to be insured to a person with an interest in the ownership of the asset during a period of time after receipt of an insurance premium. Hence, it would have been obvious to one of ordinary skill in the art of insurance at the time of applicant's invention to carry out these steps with regard to a patent right, in order to obtain the obvious advantage of profiting from writing insurance on patent rights.

The Encyclopaedia Britannica article does not expressly disclose insurance premiums being paid in connection with a transfer of ownership, but Friedman teaches what is in any case well known, paying an insurance premium in connection with a transfer in ownership (page 23, lines 24-28). Hence, it would have been obvious to one of ordinary skill in the art of insurance at the time of applicant's invention for an insurance premium to be paid in connection with a transfer of ownership, for the obvious advantage of enabling a purchaser to be more confident of the value of a purchase, and therefore more willing to buy, by providing a guarantee of the product being sold.

Claims 25 and 26 rejected under 35 U.S.C. 103(a) as being unpatentable over Fox (U.S. Patent 4,766,539) in view of the Encyclopaedia Britannica. Fox discloses the

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use of insurance forms (column 3, lines 30-40). Fox does not expressly disclose that these forms comprise a plurality of pattern areas including alphanumeric characters, but official notice is taken that it is well known in the art of insurance for various forms to comprise a plurality of pattern areas including alphanumeric characters representing various types of information. Fox does not disclose that these alphanumeric characters (per claim 25) represent intellectual property assets, the likelihood that intellectual property assets would be found valid and/or enforceable in litigation, a proposed premium for insuring against an unexpected change in value of intellectual property assets, or (per claim 26) a person designated to receive an insurance proposal form. However, the Encyclopaedia Britannica teaches that insurance is written against a wide variety of contingencies (Volume 6, page 336, column 1, lines 27-54) and that insurance involves specified premiums (Volume 6, page 335, first paragraph of article on insurance). Hence, it would have been obvious to one of ordinary skill in the art of insurance at the time of applicant's invention that such insurance proposal forms could be written, for the obvious advantage of creating written records of the corresponding insurance proposals. It is held that nonfunctional descriptive material cannot render nonobvious an invention that would otherwise have been obvious; cf. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art made of record and not relied upon as a basis for

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rejection are similar in structure, environment, or concept to applicant's invention, but do not read upon applicant's claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen whose telephone number is 703-305-0753. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins, can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications, 703-746-7240 for non-official/draft communications, and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Nicholas D. Rosen
Nicholas D. Rosen
April 4, 2002